

Docket No.: 0033-0630P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Shuichi WATANABE

Application No.: 09/451,097

Confirmation No.: 8589

Filed: November 30, 1999

Art Unit: 2621

For: IMAGE RETRIEVING APPARATUS
PERFORMING RETRIEVAL BASED ON
CODING INFORMATION UTILIZED FOR
FEATURED FRAME EXTRACTION OR
FEATURE VALUES OF FRAMES

Examiner: N. T. Diep

**PETITION TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR
PURSUANT TO RULE 1.181(C)**

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Madam:

Applicant hereby petitions to invoke the supervisory authority of the Director in the above application. As discussed in more detail below, the above application has been pending for almost nine and one-half years during which time an appeal was filed and a decision was issued by the Board of Patent Appeals and Interferences (Board) that reversed the prior art rejections that were the result of years of prosecution. This decision included a new ground of rejection under 35 U.S.C. §101 applicable to only claim 37 and applicant promptly filed an amendment to address this new ground of rejection.

The provisions of the MPEP §1214.07 as to handling returned Board decisions reversing all of the previously applied prior art rejections and MPEP §707.02 as to applications over five (5) years old notwithstanding, this application languished over one year before the issuance of an Action that appears to have failed to comply with MPEP §1214.07. It is not believed that prosecution can be further advanced until the art unit SPE and the Examiner are directed to comply with the above noted provisions of the MPEP and established requirements of note 37 C.F.R. §104(c)(2) as to designating the particular parts of the reference being relied on .

STATEMENT OF THE FACTS INVOLVED

1. This Application was filed on November 30, 1999.
2. The first Office Action on the merits in this application was mailed on May 21, 2002 and signed by the first Examiner, Richard Lee. An initial search was apparently performed that resulted in 8 references being cited by Examiner Lee.
3. Prosecution proceeded through a second Action, the filing of a CPA, an Action mailed September 12, 2003 citing three new references, a further final Action and the filing of an RCE on June 17, 2004 that was followed by yet another first Action citing two more new references. This was the last Action received prior to the below-noted Board decision that appeared to involve additional searching, whether such a search was an updated search or new search performed based on the filing of an RCE.
4. On December 15, 2005 the Appeal Brief was filed. The Examiner's Answer was not mailed until after an unaccountable delay of over eight (8) months on August 3, 2006. Such an extended delay itself appears contrary to established PTO response time goals and the above noted provisions of MPEP §707.02 as to SPE involvement.
5. On August 3, 2007, the Board of Appeals mailed its decision that reversed all of the existing prior art rejections as to claims 1, 27, and 37 and made a new ground of rejection as to claim 37 not complying with 35 U.S.C. §101 that was not a prior art based rejection.
6. On September 13, 2007, an amendment was filed addressing the new ground of rejection by the board. The amendment added a step of "storing the frame feature

value in correlating form with said frame of image data” to claim 37 but this subject matter was already presented in apparatus form by the claim 1 recital of a “frame feature value storing unit for storing said frame feature value in correlating form with the frame of said image data.” Thus, this amendment to claim 37 clearly did not require any new search.

7. An Office Action was not mailed as to this Application that should have been considered special under both MPEP §707.02 (as an application that has been pending for more than five years) and under MPEP §1214.07 (as to handling returned Board decisions reversing all of the previously applied prior art rejections) until September 13, 2008.
8. The search history obtained from private PAIR shows that a full search was conducted on April 26, 2008 during the unaccounted for year long delay period and that a copy of the file wrapper search notes also shows search consultations with other Examiners in August, just before the late mailing of the September 13, 2008 Action. They also show a consultation on February 26, 2009, just prior to the mailing of the latest Action on March 3, 2009.
9. The above-noted search history and search notes do not reflect any update search before allowance as alleged at page 1 of the outstanding Action mailed March 3, 2009.

REQUEST FOR RELIEF

In view of the extended prosecution of this application with total disregard by the SPE and Examiner as to the policy dictates set forth by MPEP §1214.04, including the requirement as to giving full faith and credit to the prior examiner's searches and the need for special and prompt handling of such applications as set forth by MPEP§707.02 as to applications over five (5) years old, Applicant respectfully requests that the Director exercise his supervisory authority to provide relief to instruct that these MPEP provisions must be followed by the Examiner and the SPE.

Accordingly, the Director is requested to instruct the SPE and Examiner that the three months required as to the mailing of the outstanding Action or the one year delay as to the

mailing of the Action of September 13, 2008 are unacceptable under MPEP §707.02 that requires the application to be “considered ‘special’ by the examiner.”

Also the Director is requested to insure that the SPE carefully studies this application to achieve the MPEP §707.02 stated goal as to all applications over five (5) years old in terms of making every effort “to terminate . . . prosecution.” Thus, the SPE should be directed to at least insure that prosecution time is minimized by insisting that the Examiner follow MPEP §1214.04 as to giving full faith and credit to the prior examiner's searches. In addition as it appears that improper searches were conducted, the Examiner should be called on to explain why the previous searches by Examiner Lee were apparently not given full faith and credit and why the additional search apparently conducted on April 26, 2008 failed to reveal the later cited Wilcox reference as well as explaining how Wilcox was found.

Besides requiring the SPE and Examiner to end unwarranted delays, the Director is requested to instruct the SPE and Examiner that they are to further comply with 37 C.F.R. §104(c)(2) that states that “the particular part [of the reference] relied on must be designated as nearly as practicable.”

Finally, these remedies are requested because the above noted unwarranted and unexplained PTO delays are prejudicial to applicant as to the term of any patent that might issue. In this last regard, this Application was filed on November 30, 1999, and only receives patent term extension based on the guide lines set forth in MPEP §2720 as to the term extension limit of five years and the requirement that extensions can only be granted as to successful appeals and application prosecution delays due to interference or secrecy orders.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Jr., Reg. No. 40,440 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: June 3, 2009

Respectfully submitted,

By 

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